<div align="center">REMARKS</div>

I. Summary of Office Action

    Claims 1-46 are pending in the application.

    The November 13, 2006 Office Action (hereinafter "Office Action") rejected claims 1-46 under 35 U.S.C. § 103(a) as being unpatentable over Stronach WO 00/67215 (hereinafter "Stronach") in view of Tulley et al. U.S. Patent No. 6,688,976 (hereinafter "Tulley").

II. Applicant's Reply to the Rejection of the Claims

    Independent claims 1 and 24 are directed toward a method and system, respectively, for placing interactive wagers on races using an interactive wagering application that is implemented using user equipment. The user is provided with an opportunity to direct the interactive wagering application to automatically select which runner or runners are to be used in a wager for a race to be run. The automatic runner selection is performed using a random-number generation application.

    Stronach refers to a multimedia system for wagering on race events. *See* Stronach, Abstract. A plurality of user terminals are provided for allowing users to input wagers. Stronach's user terminals include a button "for initiating reselection of the racing candidates." *See* Stronach, page 10, lines 21-29. The reselection of racing candidates is performed using a racing candidate selection algorithm. *Id.*

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The Examiner admits in the Office Action that Stronach fails to show or suggest the use of a "random number generation application" in the selection of racing candidates, as recited by applicant's independent claims 1 and 24. *See* Office Action, p. 3. To meet this deficiency, the Examiner cites Tulley. *Id.*

Tulley refers to a system for lottery ticket transactions where a lottery player selects multiple lottery numbers (e.g., six different numbers out of 49 possible numbers) to be used in a lottery ticket. *See* Tulley, Abstract and col. 4, ll. 34-39. Tulley states that his invention is directed to associating a lottery number combination with a limited number of occurrences. *See* Tulley, title, abstract, and col. 1, ll. 30-34. This assures a player that he will only be required to share the lottery prize with a limited number of other lottery ticket winners, thus increasing the incentive for lottery players to purchase lottery tickets. *See* Tulley, col. 1, ll. 55-59. A player in Tulley may manually select the six lottery numbers using a lottery ticket slip, or the lottery system may automatically select the lottery numbers for the player using "a 'quick pick' random process." Tulley, col. 5, ll. 1-9.

In order to establish an obviousness rejection, there must be some teaching, suggestion, or motivation to combine the teachings of the cited references to produce the claimed invention. *See In re Kahn*, 441 F.3d 977, 986, (Fed. Cir. 2006). As will be demonstrated below, there is no

teaching, suggestion, or motivation to combine Tulley with Stronach to achieve applicant's claimed invention.

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A.   There is No Teaching or Suggestion
to Use Tulley's Random Quick Pick
<u>Process to Select a Runner in Stronach</u>

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The Examiner correctly points out that Tulley states his "invention may also be used with . . . pari-mutuel racetrack betting." Tulley, col. 21, 11. 41-46. Tulley's stated "invention," however, is associating a lottery number combination <u>with a limited number of occurrences</u>. See Tulley, title, abstract, and col. 1, 11. 30-34. Nowhere does Tulley state that his invention is a random quick pick process. Therefore, when Tulley states that his invention may be used with racetrack betting, he is referring to applying his limited occurrences feature to racetrack betting, not the random quick pick process. This is confirmed when Tulley elaborates as to how his invention can be applied to racetrack betting:

> For example, some types of racetrack bets
> require that a player select, in order, the top
> three horses that will win a race. According
> to an embodiment of the present invention, a
> player may also request that his or her
> selections be associated with a limited number
> of occurrences (e.g., that his or her
> selections be unique).

Tulley, Col. 21, 11. 44-49.

Accordingly, there is no teaching or suggestion in Tulley to use the random quick pick process with racetrack

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betting, and thus no teaching or suggestion to use this process with Stronach.

> B.   There is No Motivation to Include
>   Tulley's Random Quick Pick Process
>   in Stronach's Wagering Terminals

Stronach's wagering terminals include an automatic candidate selection feature. *See* Stronach, page 10, lines 21-29. The Examiner states that by modifying Stronach to include Tulley's random quick pick process, "[s]uch a modification would provide an alternative random means of automatically selecting candidates for the player in the event that the player is indecisive about what selections to make." *See* Office Action, p. 3-4. The Examiner, however, has failed to point to any motivation why one skilled in the art would provide an "alternative" means of selecting candidates in Stronach when Stronach already includes a means for automatically selecting candidates. Applicants respectfully submit that there is no motivation for one skilled in the art to modify Stronach to include Tulley's random quick process. It is well-settled that in order to establish a *prima facie* case of obviousness based on a combination of references, there must be some "objective teaching . . . or . . . knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references," *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

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Accordingly, in view of the foregoing, there is no objective teaching, suggestion, or motivation to combine Tulley with Stronach to achieve applicant's claimed invention. Applicant submits, therefore, that independent claims 1 and 24 are allowable over Stronach and Tulley. Applicant further submits that dependent claims 2-23 and 25-46, which contain all the limitations of independent claims 1 and 24, respectively, are allowable for at least the same reasons. Applicant respectfully requests, therefore, that the rejection under 35 U.S.C. § 103(a) be withdrawn.

III.   Conclusion

For at least the foregoing reasons, applicant respectfully submits that claims 1-46 are in condition for allowance. This application is therefore in condition for allowance.

Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,

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